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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/907,635	08/08/1997	MIYUKI ENOKIDA	35.C10457CON	8513

7590 07/29/2003  
FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 101123801

EXAMINER

HONG, STEPHEN S

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 07/29/2003

56

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 08/907,635	<b>Applicant(s)</b> ENOKIDA ET AL.	
	<b>Examiner</b> Stephen S. Hong	<b>Art Unit</b> 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 12 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 87-98 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 87-98 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                 | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)         |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)             | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-914) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>54</u> | 6) <input type="checkbox"/> Other:  |

### **Part III DETAILED ACTION**

1. This action is responsive to communications: RCE and amendment filed on June 12, 2003 to the application filed 8/8/97, which is a FWC of the application Ser. No. 09/378,819, filed 1/27/95.
2. Claims 87, 92, 93 and 98 are independent claims.
3. The rejection of claims 87-98 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, and the rejection of claims 97-98 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention have been withdrawn in view of the amendment.

#### ***Priority***

4. Receipt is acknowledged of papers submitted under 35 U.S.C. § 119, which papers have been placed of record in the file.

#### ***Claim Rejections - 35 USC § 102***

- I. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:  
A person shall be entitled to a patent unless --  
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

5. Claims 87-89, 92-95 and 98 are rejected under 35 U.S.C. 102(e) as being anticipated by Bonomi, U.S. Pat. No. 5,577,191, 11/96 (filed 2/94).

As per independent claims 87, 92 and 98, Bonomi discloses the following claimed elements of a moving image editing apparatus:

- input means and decoding means for decoding encoded moving image data encoded by an encoding method that includes encoding using interframe correlation to an intraframe encoded moving image (col.2, line 54, "The video compression circuit ...compress the video data ...using both interframe and intraframe algorithm ...[and the] video decompression circuit decompresses intraframe-only compressed video data to allow editing");

- encoding means for intraframe coding the decoded moving image data and storing the intraframe encoded image data (col.4, line 25, "...in FIG.2, intraframe-only compressed video data is retrieved from storage" shows that the data have been stored.);

- editing means for decoding the image data which was stored in said storing means and intraframe encoded, and for performing an arbitrary editing on the encoded image data (col.2, line 57, "intraframe-only compressed video data ...allow video editing to occur in the host processor."); and

- second encoding means for encoding the edited image data by an encoded method that includes encoding in which the interframe correlation is considered (col.2, line 59, "When the video editing is complete, the video ....the video compression circuit to compress the video data using both intraframe and interframe algorithm.").

Bonomi further discloses displaying the decoded image data (col.3, line 52, "...decompressed the video data to display the video images on display").

As per dependent claims 88, Bonomi teaches encoding the images in MPEG, which contains the predetermined number of intra-coded pictures (see col.1, lines 25+, "the standard is the MPEG...") and JPEG (col.1, lines 40-45).

As per dependent claims 89, Bonomi teaches designating a picture for editing (col.3, lines 1-10).

Claims 93-95 recite substantially similar limitations as claims 87-89, respectively, and are similarly rejected under the same rationale.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

7. Claims 90-91 and 96-97 are rejected under 35 U.S.C. § 103 as being unpatentable over Bonomi in view of Nguyen, U.S. Pat. No. 5,404,437, 4/95 (filed 11/92).

As per dependent claims 90-91, Bonomi teaches the editing features of insertion and deletion of number of pictures. However, Nguyen discloses animation images displayed in multi-screen displays that are obtained by reducing the frame images (FIG.9 and col.9, lines 15-30). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined the teachings of Nguyen and Bonomi, since Nguyen taught the specific features of editing animation frames, and Bonomi explicitly suggested performing animation frame editions (col.1, line 52, "editing activities include special effects ..."). Nevertheless, Bonomi teaches the editing activities including "mixing, fades and wipes" (col.1, line 52), which require manipulating the number of pictures. Therefore, the features would have been obvious to a person of ordinary skill in the art at the time the invention was made in view of Bonomi's suggestions.

Claims 96-97 recite substantially similar limitations as claims 90-91, respectively, and are similarly rejected under the same rationale.

### ***Response to Amendment***

8. Applicant's arguments filed on June 12, 2003 have been fully considered but they are not persuasive.

On page 9 of the amendment, Applicant argues the following:

The Office Action asserts that Bonomi includes teaching of second encoding means for encoding edited image data. In contrast to Applicant's claimed invention, however, Bonomi is not understood to teach or suggest, among other features, performing, in a second encoding step, intra-picture coding to the

moving image data subjected to the editing process and storing the encoded data in the recording medium, and in a third encoding step reading the moving image data encoded in the second encoding step from the recording medium, converting the read data in the first encoding method, and outputting the converted data as set forth in Claim 87 and 92.

Examiner disagrees. Note that with respect to the rejection of Claim 81 above, Examiner points out the "a first encoding step" in Bonomi, since Bonomi requires that the video data be converted to the intraframe pictures for editing (see col.2, line 57, "intraframe-only compressed video data ...allow video editing to occur in the host processor."). Note that since the intraframe coded pictures are to be rasterized for the editing application, Bonomi discloses the "second decoding step". Furthermore, the second encoding step is shown, since after the rastered picture data is edited in Bonomi, the data is to be stored in the intraframe coded format. Furthermore, the third encoding step is shown since Bonomi explicitly pointed out that when the editing is done, the video is converted to the original format (col.2, line 59, "When the video editing is complete, the video ....the video compression circuit to compress the video data using both intraframe and interframe algorithm.")

### *Conclusion*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Hong whose telephone number is (703) 308-5465. The examiner can normally be reached on Monday-Friday from 8:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Art Unit: 2178

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications; please mark  
"EXPEDITED PROCEDURE")

Or:

(703) 305-9724 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121  
Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

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Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).



Stephen Hong

Primary Examiner

July 25, 2003